

REMARKS

Entry of the foregoing and reconsideration of the subject application, and Request for Continued Examination are respectfully requested in light of the comments which follow.

1. Status of the Claims

Claims pending: 1, 4-7, 9, 10, and 12-14

Claims canceled: 2-3, 8, and 11

Claims withdrawn: none

Claims rejected: 1, 4-7, 9, 10, and 12-14

Claims now amended: 1, 4-6, 10, and 12-14

Claims now canceled: none

Claims now pending: 1, 4-7, 9, 10, and 12-14

Support for the foregoing amendment can be found, for example, in at least the following locations in the original disclosure: the original claims and the specification, at least at page 3, lines 1-6.

Amendments have been made without disclaimer of, or prejudice to, any canceled subject matter. Applicants reserve the right to file a continuation and/or divisional on any canceled subject matter.

2. Acknowledgement of Receipt of Certified Priority Document

Applicants note with appreciation the indication that the certified priority document has been received in the above-identified application.

3. Acknowledgement of Information Disclosure Statements

Applicants note with appreciation the acknowledgement of the Information Disclosure Statements filed September 15, 2008; and October 28, 2009.

4. Interview Summary

Applicants acknowledge receipt of the Interview Summary for the telephonic interview conducted on October 20, 2010. In the interview, Applicants' representative informed the Office that the English language abstract was missing from the Office Action mailed on September 27, 2010. Applicants' representative requested and the Examiner graciously agreed to re-mail the Office Action with a translation of the missing reference and to restart the date for response.

5. Rejection of the Claims Under 35 U.S.C. § 112, Second Paragraph

Claims 10, and 12-14 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. The Office asserts that claims 10 and 12-14 are indefinite, because they depend from claim 2 which was canceled.

Applicants respectfully traverse the rejection to the extent the rejection is applied to the amended claims. Amended claims 10 and 12-14 depend from claim 4. Thus, Applicants respectfully submit that claims 10 and 12-14 satisfy 35 U.S.C. § 112. Reconsideration and withdrawal of the indefiniteness rejection are respectfully requested.

6. Rejection of the Claims Under 35 U.S.C. § 103(a)

6.1

Claims 1, 4-7, 9-10, and 12-14 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Luebke et al. (U.S. Patent No. 5,800,870) (hereafter "*Luebke*") in view of Sekiguchi et al. (JP 60-215895) (hereafter "*Sekiguchi*"). The Office alleges that *Luebke* discloses most of the recitations of the claims, but concedes that *Luebke* does not recite the use of an organic pigment. The Office asserts that *Sekiguchi* discloses a paper coating composition, which comprises a pigment, cationic dispersant, water soluble polymer, and cationic polymer, where the pigment includes phthalocyanine. The Office alleges that it would have been obvious to incorporate an organic pigment into *Luebke* without producing any unexpected results. The Office further alleges that the use of "any organic pigment in the primary reference" would have been obvious.

Applicants respectfully traverse the rejection to the extent the rejection is applied to the amended claims. No combination of the recite references teaches or suggests any of the organic colouring pigments recited in amended claims 1 or 4. A finding of “obviousness requires a suggestion of *all limitations* in a claim.” *CFMT, Inc. v. Yieldup Int’l Corp.*, 349 F.3d 1333, 1342, 68 U.S.P.Q.2d 1940, 1947 (Fed. Cir. 2003) (emphasis added). Amended claims 1 and 4 each recite *inter alia*:

“the organic colouring pigment is selected from the group consisting of a nitroso compound, a nitro compound, a monoazo pigment, a disazo pigment, a stilbene, a diphenylmethane, a triarylmethane, a xanthene, an acridine, a quinoline, a methine, a thiazole, an indamine, an indophenol, an azine, an oxazine, a thiazine, an aminoketone, an anthraquinone, and an indigoid derivative.”

None of the cited references teach any of the specific pigments listed in claims 1 or 4. Claims 5-7, 9-10, and 12-14 depend claim claims 1 or 4, either directly or indirectly. For at least these reasons, claims 1 and 4 and claims dependent thereon are non-obvious.

Further, there is no general teaching in *Leubke* that encompasses all pigments. The Office must establish that one of ordinary skill in the art would have had a reasonable expectation of success to practice the claimed invention. *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991). To render a claim obvious, both the suggestion of the claimed invention and the expectation of success must be in the prior art, not from the disclosure of the claimed invention. *In re Dow Chem. Co.*, 837 F.2d 469, 5 U.S.P.Q.2d 1529 (Fed. Cir. 1988). The Office seems to suggest that the sentence:

“[p]igments useful for practice of the invention include clay, calcium carbonate, titanium dioxide, silica and silicates, satin white, aluminum trihydrate, plus others known in the art” (Col. 5, lines 51-54 of *Leubke*)

serves as a suggestion that all possible pigments could be used, such that “any organic pigment in the primary reference” would have been obvious. First, *Leubke* does not suggest the specific pigments recited in claim 1 or claim 4. Further, *Leubke* does not serve to suggest that all pigments are equal and interchangeable in the compositions of claims 1 or 4, let alone interchangeable for other purposes. Instead, *Leubke* merely indicates a list of several **inorganic pigments** and speculates that other pigments from the art might also be used. At best, this is a

motivation to experiment only, but it provides no expectation of success with any one pigment over another. Neither *Leubke* nor any references cited by the Office establishes that the pigments of recited in claims 1 or 4 were known in the art or could have been substituted into *Leubke* with a reasonable degree of success. There is certainly no suggestion in *Leubke* that the **inorganic pigments** taught therein could have been replaced by an **organic pigment** as recited in claims 1 or 4, with a reasonable expectation of success. For at least these reasons, claims 1, 4, and claims dependent thereon are non-obvious. Reconsideration and withdrawal of obviousness rejection are respectfully requested.

6.2

Claim 4 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Sekiguchi*. The Office asserts that *Sekiguchi* teaches a paper coating composition which comprises a pigment, a cationic dispersant, a water soluble polymer, and a cationic polymer, wherein the pigment may be an organic pigment, such as phthalocyanine, and the cationic polymer may be SBR latex (presumably the Office means styrene-butadiene rubber). The Office concedes that the recited ranges are not taught. The Office alleges that it would have been obvious to select any portion of the disclosed ranges, including the claimed ranges.

Applicants respectfully traverse the rejection to the extent the rejection is applied to the amended claims. Claim 4 is non-obvious for the same reasons as discussed above in section 6.1. Specifically, *Sekiguchi* does not teach any of the pigments recited in claim 4, and there is no general teaching in *Sekiguchi* that renders these pigments obvious let alone provides an expectation of success. Therefore, claim 4 and claims dependent thereon are non-obvious. Reconsideration and withdrawal of the obviousness rejection are respectfully requested.

6.3

Claim 4 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Matuki (U.S. Pat. Appl. Pub. 2005/0250891) (hereafter “*Matuki*”). The Office alleges that *Matuki* discloses a water based paint comprising a water based rubber latex, an inorganic or organic pigment, and “at least one selected from the group consisting of a vulcanizing agent”, wherein the pigment may be phthalocyanine and the rubber latex may include *inter alia* styrene-

butadiene and isoprene rubber. The Office concedes that the recited ranges are not taught. The Office alleges that it would have been obvious to select any portion of the disclosed ranges, including the claimed ranges.

Applicants respectfully traverse the rejection to the extent the rejection is applied to the amended claims. Applicants respectfully submit that claim 4 is non-obvious over *Matuki* for at least the same reasons presented in sections 6.1 and 6.2. *Matuki* does not teach an organic colouring pigment as recited in claim 4. Therefore, claim 4 and claims dependent thereon are non-obvious. Reconsideration and withdrawal of the obviousness rejection are respectfully requested.

6.4

Claim 4 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Rajaraman (U.S. Patent No. 6,500,896) (hereafter "*Rajaraman*"). The Office asserts that *Rajaraman* discloses a latex based colorant comprising 5-50 percent of a latex based binder, 10-70 percent of a pigment and 0-85 percent water. The Office concedes that the recited ranges are not taught. The Office alleges that it would have been obvious to select any portion of the disclosed ranges, including the claimed ranges.

Applicants respectfully traverse the rejection to the extent the rejection is applied to the amended claims. Claim 4 is non-obvious over *Rajaraman* for at least the same reasons presented in sections 6.1 and 6.2. That is, *Rajaraman* fails to teach an organic colouring pigment as recited in claim 4. At the very least, the Office has not established a *prima facie* case of obvious. Therefore, claim 4 and claims dependent thereon are non-obvious. Reconsideration and withdrawal of the obviousness rejection are respectfully requested.

CONCLUSION

From the foregoing, further and favorable action in the form of a Notice of Allowance is earnestly solicited. Should the Examiner feel that any issues remain, it is requested that the undersigned be contacted so that any such issues may be adequately addressed and prosecution of the instant application expedited. Applicants' representative is signing in his capacity under 37 C.F.R. §1.34 on behalf of Applicants.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees or Notice of Appeal, or credit any overpayments to Deposit Account 50-0573. This paragraph is intended to be a CONSTRUCTIVE PETITION FOR EXTENSION OF TIME in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,
RAY DAVENPORT et al.

Date: January 13, 2011

By: 

William R. Childs, Ph.D.
Registration No. 62,316

Drinker Biddle & Reath LLP
1500 K Street, N.W., Suite 1100
Washington, D.C. 20005-1209
T: 202-230-5140
F: 202-842-8465